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09/641,030

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Leanne M. Capozzi

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EXAMINER

WILLIAMS, JAMILA O

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/641,030	<b>Applicant(s)</b> CAPOZZI ET AL.	
	<b>Examiner</b> JAMILA WILLIAMS	<b>Art Unit</b> 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-23 and 53-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-23 and 53-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4,9-11,21,23,53,54 are rejected under 35 U.S.C. 103(a) as being unpatentable over 5,403,138 to Otake et al (hereinafter Otake) in view of 4,204,639 to Barber et al (hereinafter Barber), in view of 5,243,173 to Dunn and further in view of 5,233,531 to Schulz.

Otake discloses a kit for organizing a plurality of images provided by a customer on a plurality of hard copy prints comprising a plurality of labels (52a-52l). Otake discloses having a form (figure 51) encompassing instructions (template 54- "EXAMPLE OF USING STICKERS") and order information (area 53,55 for example), the instruction forms being associated with a unique order instruction (the instructions provided on the form are unique to the particular photos being ordered). The examiner takes the position that this form having instructions and order information constitutes an order form and instruction form. And in that the system is for producing hard copy prints, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide multiple forms (with order information and instructions thereon) such that multiple rolls of film can be processed and multiple sets of hard copies would therefore

be provided). This modification would satisfy the limitation of having a plurality of instruction forms as recited in claim 1.

Otake does not however disclose the instruction form, labels and order form having machine readable code.

Baber teaches having labels with a machine readable code (figure 8). Dunn teaches having an order form with machine readable instructions (figure 2 and looking at col. 2 lns. 60-68, the bar codes are instructions). Schulz teaches having an instruction form with machine readable code (figure 3).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the kit of Otake with the teachings of Baber (machine readable code on the labels), the teachings of Dunn (machine readable instructions on the order form) and the teachings of Schultz (machine readable code on the instruction form) for the purpose of providing machine readable information to the end user.

In regards to claim 1, wherein the label machine readable code is used "to identify a separate category of customer provided hard copy prints", instruction form machine readable code is used "to associate each of the plurality of instruction forms with a separate label and to provide information to each customer provided hard copy image associated with the separate label" and the order form machine readable instructions used "to associate one or more of the separate category of customer provided hard copy images with at least one good or service and for ordering the at least one good or service", a recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order

to patentably distinguish the claimed invention from the prior art. In that the structure of the claims is met by the above mentioned references, it is presumed to be inherently capable of the claimed functions.

Regarding claims 2-3, Otake modified by Baber, Dunn and Schultz discloses instructions for the customer on how to use the kit (instructions on sticker placement of Otake meets this limitation) and the instructions provided on a hard copy print (column 6 Ins. 28-33 and Ins. 37-41 of Otake discloses providing labels on the original frames of the film strip to provide information about the location of the frame for example. this film strip is being considered the hard copy document and information provided from the placement of the sticker on the strip is being considered the instructions).

Regarding claim 4, Otake modified by Baber, Dunn and Schultz discloses the instructions are provided in visual format (figure 12 of Otake provides visual instructions).

Regarding claim 9, Otake modified by Baber, Dunn and Schultz discloses that the instruction form provides instruction to the photofinisher to include information on the images that follow each instruction form (column 7 Ins. 20-23 of Otake). However the specific content of the indicia set forth in the claim is not disclosed (i.e. metadata). It has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of information does not alter the functional relationship.

Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

The examiner asserts that the forms comprising indicia is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (e.g. indicia/metadata) and the substrate (e.g. form) which is required for patentability.

Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Regarding claim 10, Otake modified by Baber, Dunn and Schultz discloses the plurality of instruction forms includes a human readable order instruction, which corresponds to machine readable code (Shultz column 5 lines 34-40 teaches having machine readable code that corresponds to human readable instruction).

Regarding claims 11 and 21, Otake modified by Baber, Dunn and Schultz discloses all elements of the claims including having machine readable code. These references do not however disclose the machine readable code is in the form of an icon or color, however it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the machine readable code in the form of an icon or color as suited for the intended use and as a matter of design choice. See also the rejection of Gullack applied to claim 9 above.

Regarding claim 23, wherein the instruction forms have a size substantially the same as the size of the hard copy prints. It would have been an obvious matter of design choice to alter the size as claimed, since such a modification would have involved a mere change in size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Regarding claim 53, Otake modified by Baber, Dunn and Schultz discloses having a scanning device with an appropriate reading device to read the barcode (Dunn column 2 lines 60-67) to provide information represented by the code. In regards to the scanning device interpreting the code to provide metadata regarding one or more images, it would have been obvious to one having ordinary skill in the art at the time the invention was made to alter the specific data as suited for the intended use as a matter of design choice, see also the rejection to Gullack applied to claim 9 above.

Regarding claim 54, Otake modified by Baber, Dunn and Schultz discloses the plurality of labels, plurality of instruction forms, at least one order form as applied to claim 1 above. Regarding the limitation towards the instruction forms comprising meta data to be applied to the images, see rejection of claim 9 above.

Claims 5-7, 12-14, 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Baber, in view of Dunn, in view of Schultz and further in view of 4,730,727 to Petroff. Otake modified by Baber, Dunn and Schultz discloses all elements of the claims but for a holder and the holder including pockets or envelopes.

Petroff teaches having a holder with pockets or envelopes (figure 11 for example). It would have been obvious to one having ordinary skill in the art at the time

the invention was made to use the holder with pockets or envelopes as taught by Petroff with the kit of Otake modified by Baber, Dunn and Schultz for the purpose of organizing the hard prints and forms.

Regarding claims 12-13, Otake modified by Baber, Dunn and Schultz and Petroff discloses the kit comprises a container (figure 11), the container provided with at least one section for holding images provided in other formats (any one of the pockets or envelopes of Petroff can be considered the at least one section claimed).

Regarding claim 14, Otake modified by Baber, Dunn and Schultz and Petroff discloses the at least one section is designed to hold any one of the claimed image formats (the pockets or envelopes of Petroff are inherently capable of holding any one of the claimed formats, column 4 lines 24-25, discloses the use of the device with computer disk).

Regarding claim 16, Otake modified by Baber, Dunn and Schultz and Petroff discloses a holder having a plurality of pockets for categorizing images (figure 11- the holder with pockets of Petroff is inherently capable of being used to categorize images)

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Baber, in view of Dunn, in view of Schultz, in view of 4,730,727 to Petroff and further in view of 5,906,397 to MacWilliams et al (hereinafter MacWilliams).

Otake modified by Baber, Dunn, Schultz and Petroff discloses all elements of the claims but for the pair of identical labels for the pocket and hard copy prints.

MacWilliams teaches having a filing system having labels for associating a pocket (or file envelope) with the documents stored therein (see abstract and column 3



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lines 25-40 of MacWilliams). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the paired labels of MacWilliams with the pockets and hard copy prints as taught by Otake modified by Baber, Dunn, Schultz and Petroff for the purpose of organizing the pockets and images.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Baber, in view of Dunn, in view of Schultz and further in view of 4,057,923 to Chase. Otake modified by Baber, Dunn and Schultz discloses all elements of the claims but for the claimed carrier.

Chase discloses a carrier for holding an image (figure 9), as recited in claim 17. In that the structure is met by the carrier of Chase, it is presumed to be inherently capable of allowing for feeding and scanning as claimed.

Chase discloses the carrier comprises a support surface with an adhesive layer for holding the image (adhesive A), as recited in claim 18.

Chase discloses the carrier further includes alignment marks for assisting in positioning the image (guide lines G), as recited in claim 19 a retaining member located at one end of the carrier to securely hold the print (the upper area of adhesive EA in figure 9 for example), as recited in claim 20.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the carrier of Chase with the kit of Otake modified by Baber, Dunn and Schultz for the purpose of mounting the images.

Claims 21 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otake in view of Baber, in view of Dunn, in view of Schultz and further in view of Re. 26,663 to Dwyer, Jr. Otake modified by Baber, Dunn and Schultz discloses the plurality of labels, plurality of instruction forms, at least one order form as applied to claim 1 above. These references do not however disclose a tool for use in determining the number of images to be scanned.

Dwyer, Jr teaches a tool (31) having a scale (38) for determining the number of sheets contained therein. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the tool of Dwyer, Jr with the kit of Otake modified by Baber, Dunn and Schultz for the purpose of determining the number of images.

### ***Response to Arguments***

Applicant's arguments filed 2-12-2008 towards the application of the Shih et al. reference in the previous rejection have been considered and are persuasive. A new grounds of rejection is set forth above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMILA WILLIAMS whose telephone number is (571)272-4431. The examiner can normally be reached on Monday-Thursday 6:00am-4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. W./  
Examiner, Art Unit 3725

/Derris H Banks/  
Supervisory Patent Examiner, Art  
Unit 3725